



1762

PATENT
Customer No. 22,852
Attorney Docket No. 08137.0004-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Hiroshi SHINRIKI et al.) Group Art Unit: 1762
Application No.: 09/657,627) Examiner: B. Chen
Filed: September 8, 2000)
For: THIN FILM FORMING METHOD)
AND THIN FILM FORMING)
APPARATUS)

Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO OFFICE ACTION

In reply to the Office Action dated August 23, 2002, the period for reply having been extended three months by a request for extension and fee payment filed concurrently herewith, Applicants submit herewith a Terminal Disclaimer and an Information Disclosure Statement for the Examiner's consideration.

On August 9, 2002, Applicants filed a Request for Continued Examination along with an Information Disclosure Statement (IDS) that included a Form PTO 1449 that listed two U.S. applications, 09/658,507 and 09/641,681. Copies of the each of the listed applications were provided by Applicants for the Examiner's consideration. In the Office Action, the Examiner included a copy of the Form PTO 1449, which indicated that those applications may not have been considered by virtue of the Examiner's listing through the listing of those applications and by virtue of the handwritten designation,

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"NOT PUBLISHED" (even though application no. 09/641,681 was cited in the judicially-created double patenting rejection asserted in the Office Action).

Applicant respectfully submits that those applications should have been considered under 37 C.F.R. § 1.98, which provides for the submission of U.S. applications so long as a copy of each application listed (including the specification, claim(s), and any drawing(s) in the application) is provided. § 1.98(a)(2)(iii). Therefore, Applicants respectfully request that the Examiner acknowledge the consideration of the above-noted applications by initialing next to the listing for each of those applications on a returned copy of the Form PTO 1449 submitted August 9, 2002.

In the Office Action, the Examiner rejected claims 1-6, 8, 9, 12, and 13 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of co-pending U.S. application no. 09/641,681. Although Applicants do not necessarily agree with the propriety of that rejection, Applicants have submitted herewith a timely filed Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c), thereby obviating the judicially-created double patent rejection. Therefore, Applicants respectfully request the reconsideration and withdrawal of that rejection.

Since the only ground of rejection asserted in the Office Action dated August 23, 2002, is the judicially-created double patenting rejection, Applicants respectfully submit that all of the pending claims are allowable. Accordingly, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 21, 2003

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